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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|------------------------|---------------------|------------------|
| 09/781,388 | 02/13/2001 | Daniel Keith Tomaschko | S63.2-9711 | 2245 |

490 7590 05/28/2003

VIDAS, ARRETT & STEINKRAUS, P.A.
6109 BLUE CIRCLE DRIVE
SUITE 2000
MINNETONKA, MN 55343-9185

EXAMINER

BUI, VY Q

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| | 3731 |

DATE MAILED: 05/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|--|-----------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/781,388 | TOMASCHKO ET AL. |
| | Examiner Vy Q. Bui | Art Unit 3731 |
| <i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i> | | |
| Period for Reply | | |
| A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. | | |
| <ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). | | |
| Status | | |
| 1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>3/12/2003 (amendment and declaration)</u> . | | |
| 2a) <input type="checkbox"/> This action is FINAL . 2b) <input checked="" type="checkbox"/> This action is non-final. | | |
| 3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213. | | |
| Disposition of Claims | | |
| 4) <input checked="" type="checkbox"/> Claim(s) <u>27-30,33-39 and 41-46</u> is/are pending in the application. | | |
| 4a) Of the above claim(s) _____ is/are withdrawn from consideration. | | |
| 5) <input type="checkbox"/> Claim(s) _____ is/are allowed. | | |
| 6) <input checked="" type="checkbox"/> Claim(s) <u>27-30,33-39 and 41-46</u> is/are rejected. | | |
| 7) <input type="checkbox"/> Claim(s) _____ is/are objected to. | | |
| 8) <input type="checkbox"/> Claim(s) _____ are subject to restriction and/or election requirement. | | |
| Application Papers | | |
| 9) <input type="checkbox"/> The specification is objected to by the Examiner. | | |
| 10) <input type="checkbox"/> The drawing(s) filed on _____ is/are: a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner. | | |
| Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). | | |
| 11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner. | | |
| If approved, corrected drawings are required in reply to this Office action. | | |
| 12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner. | | |
| Priority under 35 U.S.C. §§ 119 and 120 | | |
| 13) <input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). | | |
| a) <input type="checkbox"/> All b) <input type="checkbox"/> Some * c) <input type="checkbox"/> None of: | | |
| 1. <input type="checkbox"/> Certified copies of the priority documents have been received. | | |
| 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. | | |
| 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). | | |
| * See the attached detailed Office action for a list of the certified copies not received. | | |
| 14) <input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application). | | |
| a) <input type="checkbox"/> The translation of the foreign language provisional application has been received. | | |
| 15) <input checked="" type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121. | | |
| Attachment(s) | | |
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | | |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | | |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | | |
| 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____. | | |
| 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) | | |
| 6) <input type="checkbox"/> Other: _____. | | |

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 27, 33, 42 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6, 12 and 13 of U.S. Patent No. 6,193,738. Although the conflicting claims are not identical, they are not patentably distinct from each other because they essentially claim a balloon having at least a portion of the balloon's material removed by grinding or etching.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 27-30, 33-39, and 41-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over FORMAN-5,826,588 in view of MAREIRO-6,258,099.

As to claims 27, 30, 41-42 and 45-46, FORMAN (Fig. 7, 15; abstract, lines 15-16) discloses balloon 20/98 comprising a balloon body 24, cone portions 26 and 28, waist portions 30 and 32 of substantially a same thickness (Fig. 7) or waist portion 30/32 having a thickness less than a thickness of body 24 (Fig. 15) as claimed except a process of removing the material of the balloon by grinding or etching. FORMAN does not disclose a process of removing a material from a balloon section by grinding or etching. Grinding and chemical etching are well-known processes for accurately removing material from a body. For example, MAREIRO (column 5, lines 42-46) discloses equivalent techniques for removal the material of a balloon such as laser blasting (as disclosed by FORMAN), grinding, or etching. Since grinding and etching are well known method to remove material from a balloon equivalent to the laser ablation method disclosed by FORMAN, it would have been obvious to one having ordinary skill in the art at the time the invention was made to remove the material from a portion of the FORMAN's balloon by either grinding or chemical etching process instead

of by a laser blasting process, as the grinding and etching processes are well-known process for accurate removal a material from a balloon equivalent to FORMAN laser ablation process.

As to claims 28 and 43, FORMAN (Fig. 7; column 8, lines 45-59) discloses that the thickness of the cone portions is within (more or less than) from 10% to 25% the thickness of the body portion.

As to claim 29, FORMAN (Fig. 15; column 10, lines 3-8) discloses the distal waist portion having material removed so as to reduce the distal waist wall thickness and to increase maneuverability.

As to claims 33-39, FORMAN (column 4, lines 5-10 and Fig. 7; column 8, lines 49-61) discloses balloon 16 having its distal waist wall thickness less than the thickness of its cone wall portions t_2 and less than the thickness t_1 of body portion as well.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vy Q. Bui whose telephone number is (703) 306-3420.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano, can be reached at (703) 308-2496. The fax number for this Unit is (703) 308-2708.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist at (703) 308-0858



VQB
May 24, 2003.